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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,082	08/20/2001	Akira Ebihara	KANEBO CASES	4908
7590 01/23/2004			EXAMINER	
Flynn Thiel Boutell & Tanis 2026 Rambling Road Kalamazoo, MI 49008-1699			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 01/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/806,062

Applicant(s)

EBIHARA ET AL

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory maximum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on October 27, 2003, has been entered. Claims 1 and 2 have been amended and claim 3 cancelled as requested.
2. The cancellation of claim 3 renders moot the 102 rejection set forth in section 3 of the last Office Action. Additionally, applicant's perfection of the foreign priority date by the submission of a translation of foreign priority document, JP 10-294609, is sufficient to overcome the cited prior art of JP 11-203667 (Yokoyama) and WO 99/10569 (Tani). Hence, the rejections set forth in sections 6 and 7 of the last Office Action are hereby withdrawn.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 2 stands rejected under 35 USC 103(a) as being unpatentable over US 5,899,794 issued to Shige et al. in view of the cited Tanaka, as set forth in section 5 of the last Office Action.
5. Claim 1 is rejected under 35 USC 103(a) as being unpatentable over US 5,899,794 issued to Shige et al. in view of the cited Tanaka and in further view of US 6,074,284 issued to Tani et al.

Claim 1 was previously rejected over the cited Shige and Tanaka references in view of WO 99/10569 (Tani). Since applicant has removed WO Tani as a reference, the equivalent US

Tani reference is substituted in its place. Thus, the current rejection is analogous to the rejection set forth in section 7 of the last Office Action, with the US Tani teaching of flock fiber pile length found at col. 3, lines 52-56.

### ***Response to Arguments***

6. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

7. Applicant traverses the 103 rejections over Shige in view of Tanaka by asserting that there is nothing in Tanaka which teaches the features missing from Shige, namely pile height, pile density, and cover factor (Amendment, paragraph spanning pages 16-17). The examiner agrees with this point. However, it is noted that the rejection of claim 1, which recited pile length is not over Shige and Tanaka alone, but rather in further view of Tani, which does teach the claimed pile length. Additionally, it is reiterated that, although the cited references do not explicitly teach pile density and cover factor, said features are deemed obvious over the prior art. Specifically, it would have been obvious to one having ordinary skill in the art to select a pile density and cover factor within the range claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

8. With respect to applicant's declaration under 1.132 of unexpected results achieved from the claimed ranges of pile length, pile density, fiber denier, and cover factor, said declaration is insufficient to overcome the above rejections. In particular, said declaration is insufficient due to the following:

a. The properties of surface roughness and processing speed are not described in terms of how said properties are measured and what said properties reflect about the usefulness of the invention.

b. Additionally, the overall assessment is not described in the declaration in terms of how said assessment is obtained.

c. The results do not establish unexpected results are obtained from the claimed length, density, denier, and cover factor combinations.

9. Specifically, in Tables 1 and 2, comparative examples 2-5 all have a surface roughness and speed which fall outside of the range obtained from the working examples (i.e., about 11-14 for surface roughness and 92-127 for speed), yet only comparative examples 3 and 4 get overall assessments of unsatisfactory. Even though comparative examples 2 and 5 have properties outside of the ranges presently claimed, overall assessments are good. Thus, one is left questioning the criticality of said claimed ranges in obtaining a good quality polishing tape. Additionally, said declaration does not establish that the results are at all *unexpected*. For example, wouldn't one skilled in the art expect an increase in fiber size to produce a coarser, stiffer, rougher pile surface?

10. Therefore, applicant's arguments and the declaration are found unpersuasive and the above rejections are maintained.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the

Art Unit: 1771

Examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.



CHERYL A. JUSKA  
PRIMARY EXAMINER